REMARKS

Claims 1-4 and 6-8 are pending in the instant application. Claims 5 and 9 remain canceled. Claims 1 and 2 have been amended. Applicants request reconsideration of the subject application based on the following remarks.

No new matter has been introduced by the instant amendments.

Amendment of any claim herein is not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action, and was done solely to expedite prosecution of the application. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject mattered.

35 U.S.C. §112, first paragraph rejection

Claims 1-4 and 6-8 are rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement. It is alleged that the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. Applicants disagree and respectfully traverse but nevertheless, have amended claims 1 and 2 to exclude various Markush group listings.

Applicants submit that the amendment is proper and is narrowing the scope of the claims to exclude particular compounds/groups. It is submitted that this practice has been approved by the predecessor court of the Court of Appeals for the Federal Circuit.

In In re Johnson, 194 USPQ 187 (CCPA 1977), the Requester/Patentee amended their generic claim to exclude certain species (or subgenuses) claimed in a patent of another. In reversing the USPTO's rejection of those amended claims for allegedly lacking adequate written description, the Court said that

> The notion that one who fully discloses, and teaches those skilled in the art how to make and use, a genus and numerous species therewithin, has somehow failed to disclose, and teach those skilled in the art how to make and

> use, that genus minus two of those species, and thus has failed to satisfy the requirements of §112, first paragraph, appears to result from a hypertechnical application of legalistic prose relating to that provision of the statute. . . . [T]he "written description" in the [parent application] specification supported the claims in the absence of the limitation, and that specification, having described the whole, necessarily described the part remaining. . . . **[U]nder these circumstances . . . appellants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter."** (Emphasis added)

In re Johnson, 194 USPQ at 196.

In the present application, the amendments made to claims 1 and 2 excise groups from the generic formula, and does not create an artificial subgenus or add new matter. Thus, Applicants respectfully contend that the amendments presented herein are proper and that the claims, as amended, fully comply with the written description requirement of 35 USC §112, first paragraph.

The rejection is overcome and withdrawal of the rejection is respectfully requested.

In view of the above remarks, Applicants believe the pending application is in condition for allowance. Should any of the claims not be found to be allowable, the Examiner is requested to telephone Applicants' undersigned representative at the number below. Applicants thank the Examiner in advance for this courtesy.

The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 59300CIP (71970).

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Respectfully submitted,

By _____

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